**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of:	Mark R. Nelson et al.
Serial No.:	10/621,436
Filing Date:	July 16, 2003
Group Art Unit:	2619
Confirmation No.:	1727
Examiner:	Anthony M. Sol
Title:	*Telephone-Based Hypertext Transport Protocol Server*

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Appeal Brief

Appellants have appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner electronically sent February 7, 2008, finally rejecting Claims 1-15, all of which are pending in this case. Appellants filed a response to the final Office Action on February 28, 2008, and the Examiner electronically sent an Advisory Action on April 10, 2008. Appellants filed a Notice of Appeal on April 23, 2008. Appellants respectfully submit this Appeal Brief with the statutory fee of $510.00.

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Real Party In Interest

This application is currently owned by Cisco Technology, Inc. as indicated by an assignment recorded on September 30, 1999, in the Assignment Records of the United States Patent and Trademark Office at Reel 010294, Frame 0748.

Related Appeals and Interferences

There are no known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

Status of Claims

Claims 1-15 are pending in this application and all stand rejected under a Final Office Action electronically sent February 7, 2008. Appellants present Claims 1-15 for appeal. Appendix A shows these claims involved in this appeal.

Status of Amendments

All amendments presented by the Appellants have been entered by the Examiner.

Summary of Claimed Subject Matter

For the convenience of the Board, Appellants provide the following mappings of the claims here on appeal. Appellants do not necessarily identify all portions of the specification and drawings relevant to the recited elements of the claims. Appellants provide the following mapping not to limit the scope of the claims, but to help the Board make a decision on this Appeal.

Claim 1 of the present Application recites a telephone for providing content to a client external to the telephone. The telephone (e.g., see Figures 1 and 2, elements 22; Page 8, lines 7-27) and the client (e.g., Page 9, lines 17-26) are each separately coupled to a communications network. The telephone includes a network interface (e.g., see Figure 2, element 60; Page 12, lines 3-7) that is operable to couple the telephone to the communications network and a handset (e.g., see Figure 2, element 62; Page 12, lines 7-10) that is operable to provide oral communication by a user of the telephone using the network interface. The telephone also includes a memory (e.g., see Figure 2, element 66; Page 12, lines 13-30) that is operable to store communication software and content for delivery to the client using the network interface, the content being associated with the operation of the telephone. Furthermore, the telephone includes a processor (e.g., see Figure 2, element 64) that is coupled to the memory and operable to execute the communication software to enable the telephone to receive a request from the client via the network interface for the content stored in the memory (e.g., see Page 13, lines 22-28), transmit the content from the telephone to the client via the network interface in response to the request (the content transmitted in a format for presentation in a graphical user interface on the client) (e.g., see Page 13, lines 28-32), receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface (e.g., see Page 14, lines 1-5), and execute the requested telephone-related option (e.g., see Page 14, lines 5-13).

Claim 9 of the present Application recites a remote telephone control system that includes an Internet Protocol (IP) network, a client coupled to the IP network (e.g., Page 9, lines 17-26), and a telephone coupled to the IP network (e.g., see Figures 1 and 2, elements 22; Page 8, lines 7-27). The telephone and the client are each separately coupled to the communications network. The telephone includes a network interface (e.g., see Figure 2,

element 60; Page 12, lines 3-7) that is operable to couple the telephone to the IP network and a handset (e.g., see Figure 2, element 62; Page 12, lines 7-10) that is operable to provide oral communication by a user of the telephone using the network interface. The telephone also includes a memory (e.g., see Figure 2, element 66; Page 12, lines 13-30) that is operable to store communication software and content for delivery to the client using the network interface, the content being associated with the operation of the telephone. Furthermore, the telephone includes a processor (e.g., see Figure 2, element 64) that is coupled to the memory and operable to execute the communication software to enable the telephone to receive a request from the client via the network interface for the content stored in the memory (e.g., see Page 13, lines 22-28), transmit the content from the telephone to the client via the network interface in response to the request (the content transmitted in a format for presentation in a graphical user interface on the client) (e.g., see Page 13, lines 28-32), receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface (e.g., see Page 14, lines 1-5), and execute the requested telephone-related option (e.g., see Page 14, lines 5-13).

Claim 15 of the present Application recites a telephone for providing content to a client. The telephone (e.g., see Figures 1 and 2, elements 22; Page 8, lines 7-27) and the client (e.g., Page 9, lines 17-26) each separately coupled to a communications network. The telephone includes means for coupling the telephone to the communications network (e.g., see Figure 2, element 60; Page 12, lines 3-7) and means for providing oral communication by a user of the telephone using the network interface (e.g., see Figure 2, element 62; Page 12, lines 7-10). The telephone also includes means for storing communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone (e.g., see Figure 2, element 66; Page 12, lines 13-30). Furthermore, the telephone includes means for receiving a request from the client via the network interface for the content stored in the memory (e.g., see Page 13, lines 22-28), means for transmitting the content from the telephone to the client via the network interface in response to the request (the content transmitted in a format for presentation in a graphical user interface on the client) (e.g., see Page 13, lines 28-32), means for receiving a request from the client via the network interface to execute a telephone-related option selected by the

user of the client in the graphical user interface (e.g., see Page 14, lines 1-5), and means for executing the requested telephone-related option (e.g., see Page 14, lines 5-13).

Ground of Rejection to be Reviewed on Appeal

Appellants request that the Board review the Examiner's rejection of Claims 1-6, 9, and 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,923,736 issued to Shachar ("*Shachar*") in view of U.S. Patent No. 6,584,096 issued to Allan ("*Allan*"). In addition, Appellants request that the Board review the Examiner's rejection of Claims 7, 8, and 10-14 under 35 U.S.C. §103(a) as being unpatentable over *Shachar* in view of *Allan* and further in view of U.S. Patent No. 6,430,174 issued to Jennings ("*Jennings*").

Argument

I. The Examiner's Rejection of Claims 1-6, 9, and 15 is Improper

Claims 1-6, 9, and 15 are rejected under 35 U.S.C. § 103(a) as being upatentable over *Shachar* in view of *Allan*.

Claim 1 of the Application recites the following limitations:

> A telephone for providing content to a client external to the telephone, the telephone and the client each separately coupled to a communications network, the telephone comprising:
>
> a network interface operable to couple the telephone to the communications network;
>
> a handset operable to provide oral communication by a user of the telephone using the network interface;
>
> a memory operable to store communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone; and
>
> a processor coupled to the memory and operable to execute the communication software to enable the telephone to:
>
> receive a request from the client via the network interface for the content stored in the memory;
>
> transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client;
>
> receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface; and
>
> execute the requested telephone-related option.

Independent Claims 9 and 15 recite similar, although not identical, limitations.

Appellants respectfully submit that the *Shachar-Allan* combination does not disclose, teach or suggest these limitations. First, the proposed combination does not disclose, teach or suggest a telephone that can "receive a request from the client via the network interface for the content stored in the memory" and "transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client." For a teaching of these limitations, the Office Action relies on a combination of the disclosure of telephone 100 of *Shachar* with the network device 14 of *Allan*, which that reference says can be a telephone and can be a

server application device. The present Application is directed to a telephone for providing content to a client that is external to the telephone and can communicate with the telephone via a network. As the title of the present Application states, the telephone is a *server* of content over the network. On the other hand, the telephone of *Shachar* is a *client* (a web browser) – a receiver of content. The Office Action attempts to use telephone 100 of *Shachar* to be both the claimed server and client, which Applicants respectfully submit is nonsensical given that the claims require these elements to be separate. For the same reason, any attempt to modify the teaching of *Shachar* with those of *Allan* to somehow create two separate devices connected over a network are not supportable.

Furthermore, *Allan* never discloses that network device 14 when implemented as a telephone can serve web pages or otherwise provide content for presentation in a graphical user interface on a client. Although *Allan* mentions web page hosting, it describes network device 14 very generically as basically any type of IP device and never links telephony functionality with web hosting functionality. For example, in a passage cited in the Office Action (Col. 5, lines 35-42), *Allan* specifically distinguishes between a telephony server application and a web page hosting server application. Simply because *Allan* states that network device 14 when implemented as a telephone can act as a server to provide an *IP telephony* server application does not mean that *Allan* discloses or makes obvious that a telephone can act as a web server.

Moreover, Claim 1 further requires that the telephone "receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface" and "execute the requested telephone-related option." There is absolutely no teaching or suggestion of this in either of the references, alone or in combination. Instead, the Office Action argues that this remote execution of a telephone-related option would have been obvious because "[o]ne skilled in the art would have been motivated to make the combination in order to be able to use the digital answering machine 106, fax service 107, or other services 108 [of telephone 100] remotely since it already serves as a local internal server" (citing Col. 13, lines 55-62 of *Shachar*). However, telephone 100 does not act as a "local internal server." As recognized by *Shachar* at Column 12, lines 25-31, telephone 100 is a browser. A server provides content to a remotely located

client, so by definition, telephone 100 is not a server (or, in other words, "local internal" are inconsistent with "server"). The point is that *Shachar* never contemplates serving the hypertext documents to a remote location to enable remote control of telephone 100. *Allan* also does not suggest any sort of remote operation of network device 14.

Appellants respectfully submit that the obviousness analysis provided by the Office Action is based on hindsight and uses the teachings of the present invention (remote operation of a telephone enabled by the serving of content from the telephone) to assert that the present invention is obvious, which is impermissible. *See, e.g., In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch,* 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). None of the cited art disclose, teaches or suggests remote operation of a telephone enabled by the serving of content from the telephone, and thus Appellants respectfully submit that Claim 1 is allowable for this additional reason (which the Examiner did not address in the Final Office Action). Therefore, Appellants respectfully request reconsideration and allowance of Claim 1, as well as the claims that depend from Claim 1.

Furthermore, independent Claims 9 and 15 include limitations that are similar to those of Claim 1, and thus these claims are allowable for similar reasons. Thus, Appellants also respectfully request reconsideration and allowance of Claims 9 and 15, as well as the claims that depend from Claim 9.

II. The Examiner's Rejection of Claims 7, 8, and 10-14 is Improper

Claims 7, 8, and 10-14 are rejected under 35 U.S.C. § 103(a) as being upatentable over *Shachar* and *Allan* in view of *Jennings*.

Claims 7, 8, and 10-14 each depend from one of independents Claims 1 and 9, which were shown above to be in condition for allowance. Therefore, for at least this reason, Appellants submit that Claims 7, 8, and 10-14 are also in condition for allowance. Thus, Appellants respectfully request reconsideration and allowance of Claim 7, 8, and 10-14.

Furthermore, Claims 7, 8, 13 and 14 recite remotely executing telephony functions on a telephone or remotely configuring a telephone. As noted above, these limitations are not disclosed in *Shachar* or *Allan*. Furthermore, *Jennings* does not disclose these missing limitations. For at least this additional reason, Appellants respectfully request reconsideration and allowance of Claim 7, 8, 13, and 14.

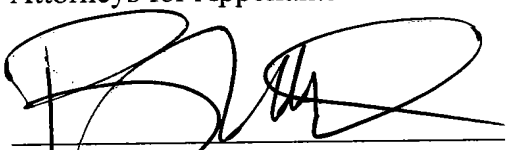
Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Please charge a fee in amount of $510.00 to cover the filing fee for this Appeal Brief to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P. The Commissioner is also authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants



Brian W. Oaks
Reg. No. 44,981

Date: June 23, 2008

Correspondence Address:

Customer Number 05073

Appendix A: Claims on Appeal

1. A telephone for providing content to a client external to the telephone, the telephone and the client each separately coupled to a communications network, the telephone comprising:

a network interface operable to couple the telephone to the communications network;

a handset operable to provide oral communication by a user of the telephone using the network interface;

a memory operable to store communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone; and

a processor coupled to the memory and operable to execute the communication software to enable the telephone to:

receive a request from the client via the network interface for the content stored in the memory;

transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client;

receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface; and

execute the requested telephone-related option.

2. The telephone of Claim 1, wherein the communications network comprises a packet-switched network.

3. The telephone of Claim 2, wherein the packet-switched network comprises an Internet Protocol (IP) network.

4. The telephone of Claim 1, wherein the network interface comprises an Ethernet interface.

5. The telephone of Claim 1, wherein the handset comprises a microphone and speaker dedicated to telephony functions.

6. The telephone of Claim 1, wherein the content stored on the memory comprises at least one HyperText Markup Language (HTML) document.

7. The telephone of Claim 6, wherein:

the client coupled to the communications network comprises an HTTP client; and

the HTML document enables a user of the telephone to remotely execute telephony functions on the telephone via the HTTP client.

8. The telephone of Claim 6, wherein:

the client coupled to the communications network comprises an HTTP client; and

the HTML document enables a user of the telephone to remotely configure the telephone via the HTTP client.

9. A remote telephone control system, comprising:

an Internet Protocol (IP) network;

a client coupled to the IP network; and

a telephone coupled to the IP network, the telephone and the client being each separately coupled to the communications network, the telephone including:

a network interface operable to couple the telephone to the IP network;

a handset operable to provide oral communication by a user of the telephone using the network interface;

a memory operable to store communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone; and

a processor coupled to the memory and operable to execute the communication software to enable the telephone to:

receive a request from the client via the network interface for the content stored in the memory;

transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client;

receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface; and

execute the requested telephone-related option.

10. The remote telephone control system of Claim 9, wherein the client comprises an HTTP client.

11. The remote telephone control system of Claim 10, wherein the HTTP client comprises a Web browser.

12. The remote telephone control system of Claim 10, wherein the content contained on the memory of the telephone comprises at least one HyperText Markup Language (HTML) document.

13. The remote telephone control system of Claim 12, wherein the HTML document allows a user of the telephone to remotely execute telephony functions on the telephone via the HTTP client.

14. The remote telephone control system of Claim 12, wherein the HTML document allows a user of the telephone to remotely configure the telephone via the HTTP client.

15. A telephone for providing content to a client, the telephone and the client each separately coupled to a communications network, the telephone comprising:

means for coupling the telephone to the communications network;

means for providing oral communication by a user of the telephone using the network interface;

means for storing communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone;

means for receiving a request from the client via the network interface for the content stored in the memory;

means for transmitting the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client;

means for receiving a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface; and

means for executing the requested telephone-related option.

Appendix B: Evidence

NONE

Appendix C: Related Proceedings

NONE